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09/584,810	05/31/2000	Dimitri Kanevsky	13539(YOR9-2000-0196US1)	2276
Richard L. Catania Esq. Scully Scott Murphy & Presser 400 Garden City Plaza Garden City, NY 11530			EXAMINER BOUTAH, ALINA A	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 09/584,810  
Filing Date: May 31, 2000  
Appellant(s): KANEVSKY ET AL.

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John S. Sensny  
Reg. No. 28,757  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed January 4, 2007 appealing from the Office action mailed December 2, 2005.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1, 2, 4-6, 8, 9, 11-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Probert in further view of CERN Conversion Service.

Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Probert in view of CERN Conversion Service.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

6,092,114	Shaffer et al.	7-2000
6,549,918	Probert, Jr. et al.	4-2003

CERN Document Service, printed from <http://documents.cer.ch/Conversion>

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

**Claims 1, 2, 4-6, 8, 9, 11-13 and 15-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaffer in view of Probert in further view of CERN Conversion Service.**

Regarding claim 1, Shaffer et al. teach a method for re-formatting computer files, comprising the steps:

inputting a data file into a computer (Abstract, col. 2, lines 30-43, i.e. receiving an attachment);

using said computer to determine if the data file is compatible with the computer or applications which exist on the computer (Abstract; col. 2, lines 31-45: determination of whether the attachment is accessible without conversion);

if the data file is not compatible with the computer, transmitting the data file over the Internet from said computer to a universal server (Abstract; col. 3, lines 4-6, lines 21-37: if the client is unable to access the attachment without conversion, a request may be transmitted to a remote server to perform conversion); and

the universal server, transforming the data file into a format compatible with the computer, and sending the transformed data file back to the computer (figure 1; col. 3, lines 21-37; col. 5, lines 22-42: the remote server performing conversion).

However, Shaffer fails to teach inputting a data file into a computer having a specified operating system; using said computer to determine if the data file is compatible with the specified operating system; said computer transmitting the data file over the internet from said computer to a universal server; and the universal server transforming the data file into a format compatible with the specified operating system of the computer.

Probert teaches inputting a data file into a computer having a specified operating system (col. 1, line 60 to col. 2, line 19: sharing of documents and other files over a network with a person using a different operating system or application); using said computer to determine if the data file is compatible with the specified operating system (col. 1, line 60 to col. 2, line 19: col. 4, lines 26-34: filter driver allowing applications to

open files in formats that they expect, thus allowing the file compatibility to be determined); and transforming the data file into a format compatible with the specified operating system of the computer (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50).

CERN teaches allowing user to upload files over the internet from a user's station to be converted (CERN: Mission statement).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. and CERN into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Regarding claim 2, Shaffer et al. teach a method according to Claim 1, wherein the transforming step includes the steps of, the universal server reading information from said computer; and on the basis of said information, identifying the type of file, and transforming the file into a different format of the same type (col. 1, line 55 – col. 2, line 3).

Regarding claim 3, Shaffer et al. fails to teach a method according to claim 1, further comprising the steps of: a user of the computer identifying user requirements; and transmitting the user requirements to the universal server; and wherein the transforming step includes the step of re-formatting the file in accordance with the user requirements.

CERN teaches a method for re-formatting a computer file comprising steps of: a user of the computer identifying user requirements; and transmitting the user requirements to the universal server; and wherein the transforming step includes the step of re-formatting the file in accordance with the user requirements (CERN User Guide, page 1-4). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of CERN into the teaching of Shaffer et al. allow the file conversion to be performed according to the user's need.

Regarding claim 4, Shaffer et al. teach a method according to claim 1, wherein, when data needs to be converted, the data are sent to a universal conversion server; the universal conversion server finds that the service cannot convert a certain file, the service looks in a computer description; the computer description can be located on the computer or on a universal conversion server database (col. 3, lines 1-13).

Regarding claim 5, Shaffer et al. fail to teach a method according to claim 1, wherein the data file is a computer program, and the transforming step includes the step of the universal server looking over the program to identify components of the program including links to the program source code, the program's executable code, the program's file name; entering data to a database of source codes, where many source codes are held; and if the same name exists among more than one program in the database, the Universal Server reads the information from the description module (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr.

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into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Regarding claim 8, this is similar to claim 1 therefore is rejected under the same rationale as specified above.

Regarding claim 9, this is similar to claim 2 therefore is rejected under the same rationale as specified above.

Regarding claim 10, this is similar to claim 3 therefore is rejected under the same rationale as specified above.

Regarding claim 11, this is similar to claim 4 therefore is rejected under the same rationale as specified above.

Regarding claim 12, this is similar to claim 1 therefore is rejected under the same rationale as specified above.

Regarding claim 13, this is similar to claim 2 therefore is rejected under the same rationale as specified above.



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Regarding claim 14, this is similar to claim 3 therefore is rejected under the same rationale as specified above.

Regarding claim 15, this is similar to claim 4 therefore is rejected under the same rationale as specified above.

Regarding claim 16, this is similar to claim 5 therefore is rejected under the same rationale as specified above.

Regarding claim 17, Shaffer et al. teach a method according to claim 1, further comprising the step of providing the Universal Server with access to a module having a series of source codes, and wherein the step of formatting the data file into a format compatible with the operating system of the computer modules the steps of:

the Universal Server obtaining from said module the source code for the data file (figure 1; col. 3, lines 21-37; col. 5, lines 22-42).

However, Shaffer does not teach the Universal Server recompiling the data file, using the source code obtained from said module, into the format compatible with the operating system of the computer. Probert teaches these limitations in (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Regarding claim 18, Shaffer fails to explicitly teach a method according to Claim 17, wherein the step of the Universal Server recompiling the data file includes the steps of the Universal Server using the source code obtained from said module to modify the source code of the data file and using a compiler to compile a new data file, compatible with computer, from the modified source code of the data file. Probert teaches using the source code obtained from said module to modify the source code of the data file (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50); and using a compiler to compile a new data file, compatible with computer, from the modified source code of the data file (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

Regarding claim 19, Shaffer fails to teach a method according to Claim 18, further comprising the step of the Universal Server reading from the computer the type of operating system on the computer. Probert teaches a universal server reading from the computer the type of operating system on the computer (col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of Probert Jr. into the teaching of Shaffer et al. in order to determine whether data can be converted locally

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and to save the description of the computer in a database so that it can be used in the future, thus maximizing the system's capability.

**Claims 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Probert in view of CERN Conversion Service.**

Regarding claim 7, Probert Jr. et al. teach a universal program conversion method, comprising the steps of:

entering data into a computer (col. 1, line 60 to col. 2, line 19: sharing of documents and other files over a network with a person using a different operating system or application);

said computer having a specified operating system and checking to determine whether the format is compatible with an operating system (OS) in the computer (col. 1, line 60 to col. 2, line 19; col. 3, line 13 to col. 4, line 57; col. 4, lines 26-34: filter driver allowing applications to open files in formats that they expect, thus allowing the file compatibility to be determined);

on the Universal Driver, reformatting the data into a format compatible to the OS (col. 3, line 13 to col. 4, line 57);

if it is determined that the data are compatible with the operating system, then checking to determine whether it is necessary to reformat the data (col. 3, line 13 to col. 4, line 57);

if the data do not need to be reformatted, processing the data as the user requests (col. 4, lines 26-34); and

otherwise, sending the data to the universal server; and this server checking whether the data are executables; if the data are executables, then checking the Universal Driver to determine whether the data can be formatted on the Universal Driver; if the data can be so formatted, then formatting the data at the Universal Driver; and then sending the formatted data to the user; if the data can not be formatted at the Universal Driver, then checking to determine if the source code exists on a storage of source code; if the source code exists, the universal driver then recompiling the data in a new OS, and the Universal driver then sending the data to the user; checking for instructions to format data; after the checking step, formatting the data are formatted according to the instructions, and then sending the data to the user (Abstract; col. 3, line 13 to col. 4, line 57; col. 5 line 34 – col. 12, line 50).

However, Probert, Jr. et al. fail to teach: if the format is not compatible, sending the data from the computer over a network to a remote Universal Drive; sending the data to a universal formatting server after the reformatting step to be converted to the format suitable for the user. CERN teaches allowing a user to send data from the user's computer to a universal formatting server for converting data suitable for the user (CERN User Guide, page 1-4). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate the teaching of CERN into the teaching of Probert et al. in order allow the file conversion to be performed according to the user's need.

#### **(10) Response to Argument**

Appellant's arguments have been considered but are not found persuasive.

In reply to Appellant's argument that the prior art does not disclose or suggest using a computer, first to determine if a file is compatible with the computer's operating system, and second, using the same computer to transmit the data file over the internet to a universal server for conversion as described in claims 1, 8 and 12, the PTO respectfully disagrees and submits that these features are taught by Shaffer, Probert and CERN combined.

Abstract, col. 2, lines 30-43 of Shaffer discloses a server receiving an email attachment be sent to a client. The receipt of the attachment is herein interpreted as inputting a file into a computer as claimed since the claim does not explicitly describe whether the file is inputted by a human user or another computer. Shaffer then teaches using said server to determine if the data file is compatible with the clients or applications which exist on the client (Abstract; col. 2, lines 31-45: determination of whether the attachment is accessible without conversion); if the data file is not compatible with the client, transmitting the data file over the Internet from said computer to a remote server (interpreted as universal server as claimed), see Abstract; col. 3, lines 4-6, lines 21-37: if the client is unable to access the attachment without conversion, a request may be transmitted to a remote server to perform conversion; and the universal server, transforming the data file into a format compatible with the computer, and sending the transformed data file back to the computer (figure 1; col. 3, lines 21-37; col. 5, lines 22-42: the remote server performing conversion).

Probert teaches inputting a data file into a computer having a specified operating system (col. 1, line 60 to col. 2, line 19). Specifically, he teaches sharing of documents and other files over a network with a person using a different operating system or

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application. In order to share files, they have to inherently be inputted into the computer. Col. 1, line 60 to col. 2, line 19: col. 4, lines 26-34 disclose a filter driver allowing applications to open files in formats that they expect. If the formats are compatible, the files may be opened, and if the formats are not compatible, the file is converted.

CERN teaches allowing user to upload files over the Internet from a user's station to be converted (CERN: Mission statement).

Claim 7 is analogous to claim 1, therefore is also rejected under similar rationale as claim 1. Specifically, the prior art does suggest using a computer, first to determine if a file is compatible with the computer's operating system and using the same computer to transmit the data file over a network to a remote universal driver for conversion as claimed.

In view of Supreme Court Decision in *KRS International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ2d 11385 (2007), the Supreme Court stated that the Federal Circuit erred when it applied the well-known teaching-suggestion-motivation (TSM) test in an overly rigid and formalistic way. According to the Supreme Court, the TSM test is one of a number of valid rationales that could be used to determine obviousness. It is **not** the only rationale that may be relied upon to support a conclusion of obviousness.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/A. N. B./

Examiner, Art Unit 2143

Art Unit: 2100

/Nathan J. Flynn/

Supervisory Patent Examiner, Art Unit 2154

Conferrees:

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